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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,340	09/26/2006	Albert H.J. Immink	GB 040077	7138
24737 7590 06/15/2009 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
LESTER, EVELYN A				
ART UNIT		PAPER NUMBER		
2873				
MAIL DATE		DELIVERY MODE		
06/15/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/599,340

**Applicant(s)**

IMMINK ET AL.

**Examiner**

Evelyn A. Lester

**Art Unit**

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 9-19-07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

2. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**\*\*\* PLEASE NOTE THIS APPLICATION WAS EXAMINED ON THE MERITS  
ACCORDING TO THE AMENDED CLAIMS FILED ON 9-26-06, NOT THE  
PUBLISHED CLAIMS FILED ON 6-15-08. \*\*\***

***Claim Objections***

3. Claim 18 is objected to because of the following informalities: In claim 18, line 2, "a comprises" does not make sense. It appears to be a typographical error. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a capacitance sensing arrangement comprising a plurality of electrode segments, does not reasonably provide enablement for any and all, future and present, capacitance sensing arrangements. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. It is required to ensure that the scope of the claim is clear so the public is informed of the boundaries of what constitutes infringement of a patent. The scope of this claim is broader than seems justified by the disclosure.

***Claim Rejections - 35 USC § 112-Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 25, these claims are considered to be indefinite because of double inclusion. Both claims 1 and 25 have an electrode arrangement and a sensing arrangement, which utilize the same elements. Claims directed to a device that can be read to include the same element twice, may be indefinite. MPEP 2173.05(o) In this case, the claims are considered to be indefinite because recited elements of a plurality of electrode segments can not be distinguished between the two arrangements, i.e. the electrode arrangement for electrically controlling the shape of the lens surface and for sensing the shape of the lens surface; and the sensing arrangement for determining the lens surface characteristics, such as shape; wherein both the arrangements utilize the plurality of electrode segments. Therefore, claims 1 and 25, and all claims dependent on these independent claims (i.e. claims 2-24), are considered to be indefinite.

With respect to claim 4, it is unclear what " , which comprises the plurality of electrode segments" modifies. This is a claim limitation already introduced in claim 1, from which claim 3 ultimately depends. It is also unclear what the "patterned top

electrode" is the "top" of? There is no structural relationship to provide a location such as "top" or "bottom," for example.

With respect to claim 15, again it is unclear what the "top electrode" is the top of? There is no structural relationship to provide a location such as "top" or "bottom," for example.

With respect to claim 16, it is unclear what the "single central electrode" is central to? There is no structural relationship to provide a location such as "central" or "top" or "bottom," for example.

With respect to claim 21, it is unclear what "comprises" an alternating current source." Does the "capacitance sensing arrangement: comprise the alternating current source, or does the "sensing arrangement" in general comprise the current source, or does the lens in general comprise the current source? If it is the "capacitance sensing arrangement" comprises the alternating current source, then inserting the term ---which--- would help to clarify this phrase, thereby reading ---...wherein the sensing arrangement comprises a capacitance sensing arrangement, which comprises an alternating current source for applying...---.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

6. Claims 1, 2, 21, 22, 24 and 25, as far as these claims are understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Herbert (US 2001/0024486 A1).

Herbert discloses the claimed invention, of claims 1 and 25, of a controllable optical lens, comprising a chamber housing first and second fluids (32 and air, Fig. 2a; or 132 and 134, Fig. 2b), the interface between the fluids defining a lens surface (130), an electrode arrangement (33 in Fig. 2b for example; or 123,124 in Fig. 3a) for electrically controlling the shape of the lens surface and for sensing the shape of the lens surface, the electrode arrangement comprising a plurality of electrode segments (123,124 in Fig. 3a) at different angular or linear orientations about an optical axis of the lens; and a sensing arrangement (50,60,70,100,102) for determining, from at least the plurality of electrode segments, lens surface characteristics at a plurality of angular or linear orientations.

With respect to claims 2 and 21, please note page 4, paragraph 25, for example.

With respect to claim 22, please note for example Paragraph 24, on page 3, elements 132 and 134.

With respect to claim 24, please note for example Figures 3a and 4a.

7. Claims 1-25, as far as these claims are understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Immink et al published article, dated 8 September 2003, entitled, "Patterned ITO contacts and Cross-Capacitance Sensing (CCS) for measuring the shape of an electro-wetting lens."

Please note the entire article, including all of the Figures. This article is the Applicants' claimed invention. The Figures of the article are the same Figures of the application disclosure.

\*\*\* Please note the published date of the article predates the file date of the foreign priority document for this U.S. patent application. The prior art need only predate the foreign priority file date in order for the prior art to be proper under 35 U.S.C. 102. Further, this article predates the effective U.S. file date, as applies under 35 U.S.C. 371, of March 29, 2005, by more than one year. Therefore, the article qualifies as prior art under 35 U.S.C. 102(b). \*\*\*

8. Claims 1-25, as far as these claims are understood, are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Please note that the authorship of the Immink et al published article (indicated above in the



prior art rejection) is different from the inventorship or inventive entity of the Applicants' claimed invention. Since the published article is the claimed invention, it is not clear why the authorship and inventorship are different.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on M-F, subject to an increased flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Evelyn A. Lester/  
Primary Examiner, Art Unit 2873